

REMARKS

Reconsideration of the pending application is respectfully requested on the basis of the following particulars.

1. In the Specification

The specification is amended, as shown in the foregoing AMENDMENT TO THE SPECIFICATION, in order to provide a more descriptive title, and to make the language used in the specification consistent with the amended title. No new matter is added, since support for the amended title can be found at least in the first full paragraph on page 2, and the seventh full paragraph on page 4 of the accompanying description in the specification.

Entry of the AMENDMENT TO THE SPECIFICATION is respectfully requested in the next Office communication.

2. In the claims

As shown in the foregoing AMENDMENT TO THE CLAIMS, the claims have been amended to more clearly point out the subject matter for which protection is sought.

A. Claim amendments

Claim 1 is amended to include the subject matter of original claims 2 and 3, and to be consistent with the amended title. No new matter is added, since the amendment merely merges originally claimed subject matter, and support for the amended title is found at least in the first full paragraph on page 2, and the seventh full paragraph on page 4 of the accompanying description in the specification.

Claims 2, 3, 5 and 6 are cancelled.

Claim 4 is amended to depend from claim 1.

Claim 7 is added to include the limitations that the memory device has a microprocessor and that prior to the step of automatically copying the application as a linked shortcut, the microprocessor determines if the memory device is connected to

the electronic device. No new matter is added, since support for these limitations are clearly found at least in the first full paragraph on page 4 of the accompanying description in the specification.

Entry of the AMENDMENT TO THE CLAIMS is respectfully requested in the next Office communication.

B. Rejection of claims 1-6 under 35 U.S.C. § 112 first paragraph

This rejection is respectfully traversed on the basis that the rejection has not met the burden required to establish a *prima facie* case of non-enablement.

The proper test to determine enablement is whether any person skilled in the art can make and use the invention without undue experimentation (MPEP §2164.01; *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988)). The initial burden is on the Patent Office to establish a reasonable basis to question the enablement provided by the specification (MPEP 2164.04; *In re Wright*, 999 F.2d 1557, 1562 (Fed. Cir. 1993)).

There are at least eight factors that must be analyzed to make a finding of non-enablement (MPEP §2164.01(a); *In re Wands*, 858 F.2d at 737 (Fed. Cir. 1988)). While it is not necessary to discuss every factor, the language of the rejection should focus on the factors, reasons, and *evidence* that lead the Office “to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation” (MPEP §2164.04, underlining in original). The analysis can be done “by making specific findings of fact, supported by evidence, and then drawing conclusions based on these findings of fact” (MPEP §2164.04). In a situation where the Office alleges there is missing information in the specification, the Office “should specifically identify what information is missing *and why one skilled in the art could not supply the information without undue experimentation*” (MPEP §2164.04, emphasis added).

In the pending case, the rejection states that there is no discussion of how to implement the method described in the pending claims, and further the rejection

requires disclosure in the specification of technical information specifically relating to how the linking and copying of the shortcut is to occur.

There is no analysis or findings of fact relating to any of the eight factors, for example the level of ordinary skill in the art that are used to make a finding of undue experimentation. The rejection merely points out what is allegedly missing, skips the evidentiary findings required to make a *prima facie* case of undue experimentation, and jumps to the conclusion that the claims are not enabled.

This analysis is improper and conclusionary and fails to meet the burden required by the Office to establish a *prima facie* case of non-enablement.

Accordingly, withdrawal of this rejection is respectfully requested.

3. Rejection of claims 1-3, 5 and 6 under 35 U.S.C. § 102(b) as being anticipated by U.S. publication 2002/0143637 (Shmueli et al.)

This rejection is respectfully traversed on the basis that the Shmueli et al. publication fails to disclose each and every limitation of claim 1. With regards to claims 2, 3, 5 and 6, the rejection is rendered moot by the cancellation of claims 2, 3, 5 and 6.

The Shmueli et al. publication fails to disclose automatically copying an application as a linked shortcut from a memory device to the operating system (OS) of an electronic device, showing an icon for the link on the screen of the device and clicking the icon to run the application, as is required by pending claim 1.

The Shmueli et al. publication discloses a key 10 having software 20 stored in memory 18 on the key (paragraphs [0026] and [0029]). When the key is inserted into a host, the applications in the software on the key will automatically execute (paragraphs [0027] and [0029]). One of the preferred applications provides for launching an interface bar on the screen of the electronic device in order to provide a user interface to the functions provided by the key (paragraphs [0047] and [0052]).

So, while the Shmueli et al. publication discloses launching an interface bar on the screen of an electronic device and clicking the bar to run an application, there is

no disclosure or suggestion to copy an application as a linked shortcut from the memory device to the OS of the electronic device and showing an icon of the shortcut on the screen of the electronic device, as required by claim 1.

In the method of the Shmueli et al. publication, when the key is interfaced with the host, the key will emulate a file system on a solid state mass storage device (paragraph [0027]). This emulation of a file system does not the function in the same way as the pending claims, where the application on the memory device is copied as a linked shortcut to the OS of the electronic device, and an icon of the linked shortcut is shown on the screen of the electronic device.

Further, in the method of the Shmueli et al. publication the software applications on the key will open existing applications that are stored on the host with user preference data retrieved from the key, thereby writing information to the host. This is in contrast to the method of claim 1, where the software applications are stored and run from the memory device itself and not from the host device. In this way, the software applications stored on the memory device do not need to be installed onto the host while being executed within the host.

Since the Shmueli et al. publication does not disclose every feature of claim 1, withdrawal of this rejection is respectfully requested.

With regards to new claim 7, the Shmueli et al. publication does not disclose a memory device having a microprocessor where the microprocessor determines whether the memory device is connected to the electronic device prior to automatically copying the application as a linked shortcut to the operating system of the electronic device.

4. Rejection of claim 4 under 35 U.S.C. § 103(a) as being unpatentable over U.S. publication 2002/0143637 (Shmueli et al.) in view of U.S. publication 2003/0110371 (Yang et al.)

This rejection is respectfully traversed on the basis that the Yang et al. publication does not make up for the deficiencies of the Shmueli et al. publication discussed above with reference to claim 1, from which claim 4 depends.

The Yang et al. publication discloses a device similar to that used in the Shmueli et al. publication in that user preferences on the portable storage device are used when opening and running applications that are stored on a guest PC. There is no disclosure or suggestion in the Yang et al. publication to automatically copy an application as a linked shortcut from a memory device to the operating system (OS) of an electronic device, showing an icon for the link on the screen of the device and clicking the icon to run the application, as is required by pending claim 1, from which claim 4 depends.

Therefore, withdrawal of this rejection is respectfully requested.

With regards to new claim 7, the Yang et al. publication does not disclose a memory device having a microprocessor where the microprocessor determines whether the memory device is connected to the electronic device prior to automatically copying the application as a linked shortcut to the operating system of the electronic device.

5. Conclusion

As a result of the amendment to the claims, and further in view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that every pending claim in the present application be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the applicants' attorney, the examiner is invited to contact the undersigned at the numbers shown below.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read "Justin J. Cassell", written over a horizontal line.

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